

Applicant: David S. Lawrence  
Serial No.: 10/755,086  
Filed: January 9, 2004  
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#### REMARKS

Claims 49, 56-71, 73-80, 82-84, 86-123, 127-131, 133-134 and 137-147 were pending in the subject application. By this Amendment, Claims 103-121 and 144-145 have been canceled without prejudice or disclaimer, and Claims 49, 56, 61-62, 88, 129 and 133 have been amended. Accordingly, upon entry of this amendment, Claims 49, 56-71, 73-80, 82-84, 86-102, 122-123, 127-131, 133-134, 137-143 and 146-147 will be pending.

Applicant maintains that the amendments do not raise an issue of new matter. Support for the amendments to Claims 49, 129 and 133 can be found at least in the previous version of the claims. Support for the amendment to Claim 56 can be found at least on page 4 of the application in the last sentence of the first paragraph and in paragraph [0010] and in the previous version of the claim. Support for the amendments to Claims 61-62 can be found at least in the previous version of the claims and in Claim 60. Claim 88 has been amended to recite the structures found in Table 3. Accordingly, entry of the amendment is respectfully requested.

#### Allowable Subject Matter

Claims 89-91, 95, 97-100, 102, 122, 123, 134, 137, 142, 143, 146 and 147 are allowable.

#### Request for re-instatement of withdrawn species claims

Pending dependent Claims 92, 93, 94, 96 and 101 are currently withdrawn from consideration by the Examiner as directed to non-elected species. In view of the allowability of independent Claim 90, from which Claims 92, 93, 94, 96 and 101 depend, re-instatement and consideration of these withdrawn claims are respectfully requested (37 CFR §1.141, MPEP §806.04(d)).

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Similarly, upon allowability of independent Claim 56, re-instatement and consideration of withdrawn dependent Claims 70, 79, 80, 82 and 84 are respectfully requested.

#### Claim Objections

Claims 130 and 131 are objected to because they depend from a withdrawn claim. Claims 130 and 131 depend from Claim 129, which has been rewritten to depend directly from allowed Claim 90. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

#### Rejections under 35 U.S.C. §112, Second Paragraph

Claims 61 and 62 are rejected as indefinite for not further defining the limitations in the claims. Claims 61 and 62 have herein above been amended to clarify the claims. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Independent Claim 88 and dependent Claims 140 and 141 are rejected because Claim 88 refers to compounds set forth in Table 3 instead of reciting the compounds. Claim 88 has herein above been amended to recite the structures in Table 3, thereby obviating this rejection.

Claims 129 and 133 are rejected as depending from canceled claims. Claims 129 and 133 have been rewritten to depend directly from allowed Claim 90, thereby obviating this rejection.

#### Rejections under 35 U.S.C. §112, First Paragraph

Claims 49, 56-69, 71, 73-78, 83, 86, 87, 103-109, 112, 114, 116-119, 121, 127, 128, 138, 139, 144 and 145 are rejected as failing to comply with the written description requirement. The Examiner indicated that independent Claims 49, 56 and 103 fail to

comply with the written description for the breadth of the claims. The Examiner indicated that the claims are directed to a chemical compound comprising a polypeptide but the structure of the polypeptide is not adequately disclosed in the claims, that the “polypeptide” can encompass any fragment of the amino acid sequence of the polypeptide and that the claims are thus overly broad.

Claim 103 and dependent claims 104-109, 112, 114, 116-119, 121, 144 and 145 have been canceled without prejudice or disclaimer, thereby rendering this rejection moot with respect to the canceled claims.

Claim 49 has herein above been amended to refer to specific substrates. Accordingly, reconsideration and withdrawal of the rejection of Claim 49 and dependent Claims 138 and 139 are respectfully requested.

Applicants respectfully traverse this rejection with respect to Claim 56 and its dependent claims. Claim 56 has been amended to recite “[a] substrate for a protein kinase, wherein the substrate comprises:

- a peptide substrate for the protein kinase, wherein the peptide comprises a serine, a threonine, or a tyrosine on a terminal end of the peptide;

- at least one fluorophore, wherein a fluorophore is attached to the serine, the threonine, or the tyrosine on the terminal end of the peptide; and

- a photolabile side chain attached to the serine, the threonine, or the tyrosine on the terminal end of the peptide...”

Applicant maintains that the skilled artisan would understand that for the substrate to be a substrate for a protein kinase, then the peptide itself must be the substrate for the protein kinase, rather than the fluorophore or the photolabile side chain (see for example paragraphs [0007], [0009], [0098] and [0105] of the application). The skilled artisan would also understand that different protein kinases have different substrates. The specificity of protein kinases for their substrates is discussed for example in paragraphs

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[0007], [0009], [0098] and [0105] of the application and references cited therein. The peptide in Claim 56 is not any peptide, but rather is a peptide that is a substrate for a protein kinase. The claim has been amended to clarify this point. The invention of Claim 56 is not a particular peptide that acts as a substrate for a protein kinase, but rather the labeling of the peptide with the fluorophore in ways such that the substrate undergoes large changes in fluorescent intensity upon phosphorylation. Applicant respectfully maintains that the claimed invention is described in the specification such that the skilled artisan would understand that the inventor had possession of the claimed invention at the time the application was filed. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

#### Supplemental Information Disclosure Statement

In accordance with the duty of disclosure under 37 C.F.R. §1.56, applicant would like to direct the Examiner's attention to the reference listed on attached Form PTO/SB/08A (1 page).

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CONCLUSIONS

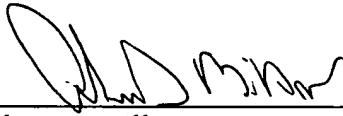
In view of the amendments and remarks made hereinabove, reconsideration and withdrawal of the objections and rejections set forth in the February 7, 2008 Office Action and passage of the pending claims to allowance are respectfully requested. If there are any minor matters preventing the allowance of the subject application, the Examiner is requested to telephone the undersigned attorney.

A check in the amount of \$180.00 is enclosed for the fee for submitting an Information Disclosure Statement. No additional fee is deemed necessary in connection with the filing of this response. However, if any other fee is required to preserve the pendency of the subject application, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 01-1785.

Respectfully submitted,

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Dated: May 7, 2008  
New York, New York

By   
Alan D. Miller, Reg. No. 42,889